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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,629	12/15/2000	Richard Paul Messmer	85CF-00114	7892
7590	10/08/2004		EXAMINER	
John S. Beulick Armstrong Teasdale LLP Suite 2600 One Metropolitan Sq. St. Louis, MO 63102			FULTS, RICHARD C	
			ART UNIT	PAPER NUMBER
			3628	
DATE MAILED: 10/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

KB

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/737,629	MESSMER ET AL.	
	Examiner	Art Unit	
	Richard Fults	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 30 June 2004.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-10 and 12-42 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 and 12-42 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

An amendment has been received which canceled claim 11 and added claims 34-42. According claims 1-10 and 12-42 are presented for consideration on their merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-10 and 12-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The verb "underwriting" is not defined within the specifications and is not being used in this application as defined by standard business and investment dictionaries. In those dictionaries underwriting is defined to mean taking on risk for profit regarding the purchase and resale of New Issues or Secondary offerings only: it has nothing to do with the valuation of securities already issued and in an investment portfolio.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 and 12-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The verb "underwriting" is not defined within the specifications and is not being used in this application as defined by standard business and investment dictionaries. In those dictionaries underwriting is defined to

mean taking on risk for profit regarding the purchase and resale of New Issues or Secondary offerings only: it has nothing to do with the valuation of securities already issued and in an investment portfolio.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-10 and 23 and 34-42 are rejected under USC 101 as the claimed invention is directed to non-statutory subject matter. For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result,

AND

2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section IV 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. *In Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4.** Claims 1-10 and 12-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bukowsky (US 5,934,674 A) (hereinafter Clifton) in view of Tull et al (US 5,946,667 A) (hereinafter Tull) and Downes, Dictionary of Finance and Investment Terms, 1998.

Clifton discloses (see at least columns 1-6) all the steps, methods, systems, and means described within claims 1-33, including calculating an initial asset value for the portfolio, recalculating asset value based on progressively improving asset valuation data, a computer configured as a server and further configured with a database of asset portfolios and to enable valuation process analytics, at least one client system connected to said server through a network, and server configured to calculate an initial asset value for the portfolio and recalculate asset value based on progressively improving asset valuation data. Claims 2-11, 13-22, 24-33, and 35-42 are rejected as being dependant upon rejected independent claims 1, 12, 23 and 34. Clifton does not teach a network.

Tull discloses (see at least columns 1-22, but in particular columns 1-8) the use of a computer on a network for calculating and recalculating portfolio asset valuation data based on progressively improving asset valuation data.

Downes (see pages 671-2) defines investment underwriting to be applicable only to new issues or secondary offering, not issued stock already in a portfolio.

Because it would have been commonsense and advantageous and would have provided a more comprehensive and efficient method of valuation of assets it would have been obvious to one skilled in the art at the time of the invention to add the teachings of Tull to those of Clifton, and to have added those of Clifton to Tull for the same reasons.

Official Notice is taken that because it has long been common and well known since at least the 1980s, and particularly since the early 1990s, to value securities in portfolios over a network using computers and recalculating the value whenever prices changed it would have been obvious to one skilled in the art at the time of the invention to do so in whatever format or sets or sequence as would be convenient and advantageous.

5. Note is taken by the examiner that should the applicant find objectionable any statements made herein by the examiner regarding obviousness, or Official Notice, Applicant can make a proper challenge to those statements only by providing adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying those statements: a simple response requesting a reference without doing so, or a response that fails to logically refute the basic assumptions underlying the justification, will result in an improper and failed challenge and those unchallenged statements will remain the record of the case. Applicants must seasonably challenge those statements in the first response following an Office Action. If an applicant fails to do so, his right to challenge them is waived.

## 6. **Response to Applicant's Arguments**

Applicant has been non-responsive to the rejection under 101 for lack of technology **within the body of the claims**. The references provided and the obviousness statements anticipate the claims of the applicant, and apply equally to the new claims 34-42, as well as to all the amendments made to other claims. The new introduction of the incorrect verb "underwrite" created an enablement and indefiniteness problem and rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is 703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough, can be reached on (703)-305-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



RCF

10/1/2004



JEFFREY PWU  
PRIMARY EXAMINER